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I. Real Party in Interest

The present application is assigned to WW MapOut Solutions, a corporation duly organized under and pursuant to the laws of Sweden, and having its principal place of business at Järfälla, Sweden.

II. Related Appeals and Interferences

The Appellant's legal representative, or assignee, does not know of any other appeal or interferences which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-20 are currently pending in the application and are the subject of the present appeal.

IV. Status of Amendments

No amendments to the claims were proposed subsequent to the Final Rejection.

V. Summary of the Invention

The present invention is directed towards displaying information about patents in a manner that is easily interpreted, thereby enabling a user to determine the value of a patent or possible future patent.

The value of a patent, or group of patents, is often difficult to discern. There are many factors involved in making such as determination, for example, the

marketable value or strength of the patent with respect to other patents of similar technology. [Paragraph 2, page 1]

Currently, there are few means by which someone can make a determination of the value or strength of a patent. There are several resources and databases that contain information about published or issued patents in various countries. However, even with the vast amount of information available from these sources, only the information pertaining to an individual patent can be viewed. Therefore there is need to provide those wishing to evaluate the validity and strength of patent portfolios, with various information concerning patents in a manner that is easily viewed and understood. [Paragraph 3, page 1]

The present invention provides means for displaying information associated with one or more patents in a statistical format for easier interpretation of the data. The invention also provides means for obtaining and statistically displaying cited references and patents that correlate to each group or subgroup of classified patents. [Paragraph 5, page 2]

According to the invention, patent data, for example assignee, abstract, title, classification, cited references, and the like, is acquired from various bibliographical databases, for example Dialog and STN. The acquired data is linked to each other and stored in internal databases. The data is linked by what is referred to as "tight links" and "loose links". A tight link is when information is directly linked to the patent record by access or patent number of the patent. Therefore, any data retrieved pertaining to a patent is stored under the patent number representative of that patent and is hence directly linked or "tight linked" to that patent record. A loose link is when information that does not contain a patent number or may not be directly related to one particular patent but several patents, such as a group of patents assigned to a company or related to a specific technical art, is linked to those patents or group of patents by other parameters. These other parameters can be company name, inventor(s), classification and the like. Once the loose links have been linked to the patent or patent groups, the user can determine if the information is pertinent to a particular patent record and tight link them to that specific patent record.

[Paragraph 18, pages 3 to 4]

Since the data represents records of patents and because different parts of the data may come from different databases, it is necessary to link together all the different data that corresponds to an individual patent. Fig. 3 is a flow chart outlining the preparation that takes place before data can be imported. During this preparation a parameter file is created 305 and stored in a storage medium 310. The parameter file is based on the bibliographical information of the data to be obtained. This usually includes the title, access number and/or classification code. However, any bibliographical information can be used in the parameter file. When comparing files from different databases in different columns any bibliographic information can be used that is universal across the different databases. Based on the parameter file created, data is then extracted from the database and imported. [Paragraph 29, page 6]

Starting at A 315, the user connects to a database 320. In 305, a parameter file is prepared and stored in 310. In 335, it is determined what column the data is going to be imported into. This can be any column that is selected by the user. In step 340, a determination is made whether the imported data is going to be compared with each other or merged together. If the data is to be merged with other imported data, then the data is marked 345 to merge with an earlier imported column of data. If the data is going to be compared with other columns of data, then the data is marked to create a new column 350 for the data. It is determined whether or not the field to group the data is automatically chosen 355. If the field is not automatically chosen, then in step 360 the common field to group the data is chosen in accordance with the data from the parameters 390. If the field is automatically chosen, then in step 365 it is determined whether to group by patent class or not. If the data is not grouped by a patent class, then in step 370, the data is grouped by a fixed number of characters in the field, or based on characters to the left or right of a delimiter or space in the common field. If the decision is made to group on the patent class, then in 375, the origin of the file is found and the parameters extracted. Control then proceeds to step B 385. [Paragraph 30, page 7]

Fig. 4 is a flowchart that outlines the grouping of content from the different databases. The relevant fields contained in a record, based on the parameters of

Fig. 3, are imported 410 from the patent file 405. In step 420, it's determined whether or not the patent record has already been imported. This is accomplished by comparing the record identifier i.e. access number, with those already obtained. If the patent record has already been acquired within the current column, then control returns to step 410 and a different patent record is imported. If the patent record has not already been imported, meaning a duplicate is not found, then in step 425, the patent record is grouped based on a common field. [Paragraph 32, page 7 to 8]

In step 430, hierarchies of the patent classes within the current patent are built up and all the patent records are summed based on the patent class in which they are located. If no class exists, then class Z is inserted to represent that no class exists in the record. In step 435, it is determined if the data is duplicated in another column. If the data is already present in another column, then in step 440 the column I.D. and sum is stored. If a duplicate is not found then in step 445, the record identifier i.e. access number, patent number etc., title, category, class, hierarchy, sum and column I.D. of the patent record are stored within an internal database of the present invention. In step 415, the class and description are stored. This data is linked to steps 430 and 485. In those steps data can be retrieved from step 415. [Paragraph 33, page 8]

The parameters are contained in file 450. In step 455, it is determined whether to sum up the groups based on the first characters. If the groups are summed based on the first characters, then in step 465, the groups are summed based on the number of characters selected by the user in the common field. If no common field exists a Z is inserted. If the data is not grouped based on the first characters, then the grouping is based upon the characters 460 to the left or to the right of a delimiter or space in the common field. A Z is inserted when no common field exists. After steps 460 and 465, the data is stored in steps 470 and 475. [Paragraph 34, page 8]

In step 480, a determination is made whether or not more patent records are to be obtained. If more records are to be obtained, then control returns to step 410. If all records have been obtained, then in step 485 descriptions are added to the built

up groups/hierarchies and the individual classes or fields to which the records belong. In step 490, it is determined whether more files from the external databases are needed. If more patent files are needed, then control returns to step 315 of Fig. 3. If no more patent files are needed, then in step 495, the routine stops. [Paragraph 35, page 8]

Fig. 5 is a flowchart that outlines the steps for acquiring citation information on the patent records obtained. The citation information are the patents and articles, that were cited as references in the prosecution of the patent. The steps for acquiring citation information is similar to the steps used to acquire the patent records of Fig. 4. The citation information is usually acquired from databases such as the Derwent Patent Citation Index, however any database that contains citation information may be used to acquire the citation information. [Paragraph 36, page 9]

In step 510 relevant fields from a patent record, including citation information, based on the parameters of the patent file 505 are imported. In step 515, it is determined if the record has already been obtained. If the record has already been obtained then, in step 520, the citation information is stored and then control continues to step 575. If the record has not been obtained, then it is decided, in step 525, whether to group the record on the patent class it belongs to or not. If the record is grouped on the patent class, then in step 530 hierarchies of the patent classes within the current patent are built up and the records in each patent class are summed, to give a total of all records obtained that belong in that class. In step 535, it is determined if the data is duplicated in another column. If the data is already present in another column, then in step 540 the column ID, citation information and summed number is stored. If a duplicate is not found then in step 545, the record identifier i.e. access number, patent number etc., title, category, class, column I.D. and citation information of the patent record are stored within an internal database of the present invention. [Paragraph 37, page 9]

If the patent record is not grouped by the patent class, then in step 555, it is determined whether to sum up the groups based on the first characters. If the groups are summed based on the first characters, then in step 565, the groups are summed based on the number of characters selected by the user in the common

field. If no common field exists a Z is inserted. If the data is not grouped based on the first characters, then the grouping is based upon the characters 560 to the left or to the right of a delimiter or space in the common field . A Z is inserted when no common field exists. After steps 560 and 565, the data is stored in steps 570 and 575. [Paragraph 38, page 9]

Once the patent data has been imported and the data configured to the users desires, the data can be displayed and viewed in a statistical format. This gives the user an overall view of the patents that were imported and how they relate to each other. Fig. 6 is an exemplary screen display showing a statistical view of the imported patent data, set up in the manner as described in Fig. 2. In this example, the data is categorized according to the year in which the patent was published 610 and the international patent classification (IPC) 605. The total number of patents pertaining to each year is located on the second row. In the first column, starting on the third row, are the IPC classifications 640. On each row adjacent to the IPC classifications, under each year, are the number of patents 635 in that classification for that particular year. For example, in the sixth row under the classification B, there are 24 patents classified under B in 1994, 20 in 1995, 27 in 1996, 46 in 1997 and 60 in 1998. [Paragraph 40, page 10]

To view the individual patents in any particular row or column, the user simply selects that column and row by clicking on it with a mouse or similar device. The titles corresponding to the row and column selected will appear. As the user is viewing the titles, they can select or have the titles thrown out. Therefore, as they view the titles the patents of interest can be selected and those titles will move in another section for selected titles. Also, the patents that aren't desired for whatever reason may be selected and moved to another section for thrown titles. This gives the user a clear view of what is selected and what isn't, this information will be stored and used when further selections are made. [Paragraph 42, page 10]

The view pull down menu 620 allows the user to view other data corresponding to the selected and thrown titles. When selected the menu 620 provides several options, these include displaying the selected titles, the access numbers or reduced access numbers, the thrown titles, displaying the selected

bibliographical records or all bibliographical records. When the access number option is used, the access numbers corresponding to the selected titles are listed in different formats that can be used to obtain the entire patent in various databases. The reduced access number only provides the access numbers for selected titles that do not have corresponding bibliographical records. If the user chooses to display the bibliographical records, the bibliographical records for the selected titles are displayed in a separate section. Comments concerning the abstract can be added in a comments section. The bibliographical records can also be marked for priority. Another feature that is provided is the ability to classify the bibliographical records under classifications that the user selects, thus providing the user with the freedom to manipulate the data and view it according to their needs. All the bibliographical records can be exported or a subset of the records can be exported based on information entered by the user. The records can be imported into the current or a new internal database, where the user defined classes can be used to group the information and thus create a new view of the information. [Paragraph 43, page 11]

A good way to view the value of a patent or a group of patents is to look at the number of citing patents/patent applications that are referenced to those patents or group of patents, as this may indicate that many others are interested in the same technology. A large number of citing patents does not always mean that the cited patent is highly valuable. However, by combining this information with other parameters the user can be given a multitude of information to draw their conclusions of the strength and/or validity of the patent or patent group. Other parameters may include information from the Derwent Patent Citation Index, the number patents/patent applications within the patent family and/or the number of countries that patents are designated or filed. If these other parameters provide additional validation to number of citing patents, then this may indicate that the patent/patent applications are strong patents and worth protecting. [Paragraph 45, page 11 to 12]

Also, if there are a large number of cited patents/patent applications and/or a large number of literature citations then, because of the vast amounts of prior art,

this might indicate that the patent/patent applications are weak. Each of these indicators is not enough to judge the value and/or strength of the patent content but, the information combined and with the patents grouped in a manner easy to view, provides a fast and easy way to know the value and strength of a single or many patents and where there is a high probability of finding valuable patents. [Paragraph 45, page 12]

Therefore, the conclusions drawn by the user can be validated or strengthened by this additional information. It should be noted that the information is not limited to the parameters specified above. Any parameter that provides information on patents can be used. [Paragraph 46, page 12]

VI. The Issues

1. Whether claims 1-12 are properly rejected under 35 U.S.C. §101.
2. Whether claims 1-9, 11, 12 and 20 are properly rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,721,910 to Unger et al. ("Unger").
3. Whether claims 10 and 13-19 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Unger.

VII. Grouping of Claims

For purposes of this appeal: Claims 1-9, 11, 12 and 20 stand or fall together; claim 10 stands alone; claims 13-17 stand or fall together; claim 18 stands alone and claim 19 stands alone. The reasons the claims are grouped as above are explained below in the "Argument" sections.

VIII. Argument

A. Claims 1-12 Are Not Properly Rejected Under 35 U.S.C. §101 as Allegedly Being Directed to Non-Statutory Subject Matter.

As discussed above, the invention is directed towards acquiring data, corresponding to patents for example, across various databases and the display of that data in a manner that aids in determining the strength or value of the patent or a group of patents, as related to other patents. To accomplish these tasks, patent data is acquired from various databases based on a parameter file(s), grouped into at least one category, and stored in internal databases. A user can then select a desired category for display and the records corresponding to the selected categories are retrieved and displayed.

Accordingly, independent claim 1 defines a method for managing data. The method includes, *inter alia*, the steps of: creating a parameter file; establishing a link with a database; importing bibliographic data from the database based on the parameter file; grouping the imported data into at least one category; storing the bibliographic data in at least one internal database; linking together the corresponding imported data to form a record; selecting at least one category for viewing; retrieving the records from the selected categories; and displaying the records by the selected categories. Therefore, the invention as recited in claim 1 meets the requirements of 35 U.S.C. §101 because it is within the technological arts and produces a "useful, concrete and tangible result." *State Street Bank & Trust Co. v Signature Financial Group Inc.* 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-0 (Fed. Cir. 1998).

In rejecting claim 1, the Examiner asserts that the claim language in and of itself does not establish the context of a computer-implemented invention. Furthermore, the Examiner asserts that claim 1 "speaks to a library with an index card file, not computerized." First, this assertion is unfounded for at least the reason that the terms recited in claim 1, for example, "parameter file", "link", "database", "imported data", "internal database", "records", "displaying" and the like, when given their ordinary meaning and read in view of the specification, clearly define a

computer-implemented method which produces a useful concrete and tangible result.

Second, even if the claims are construed in the manner suggested by the Examiner, such an interpretation does not run afoul of 35 U.S.C. 101. It can hardly be argued that an index card catalog in a library is an abstract concept that does not provide a "useful, concrete and tangible result." If it did not, it is difficult to understand why such a system has been employed for so long, both in its original paper form and now in its computerized form. Without such a card catalog, library patrons would have a difficult time finding references. The databases and records recited in claim 1 clearly provide tangible results within the technological arts.

Accordingly, independent claim 1 is directed to statutory subject matter. Claims 2-12 variously depend from independent claim 1. Therefore, claims 2-12 meet the requirements of 35 U.S.C. §101 for at least those reasons presented above with respect to claim 1.

B. Claims 1-9, 11, 12 and 20 Are Not Properly Rejected Under 35 U.S.C. §102(a) as Being Anticipated by Unger.

Unger discloses a multi-dimensional database that models a scientific or technical body of work. The database system of Unger contains a hierarchical model of a complex business, scientific or technical entity and the associated technical documents which reflect each aspect of the model. The database disaggregates the set of technical documents associated with the business or entity into discrete technical categories by use of a set of predefined search protocols which match the scientific or technical concepts within the model. The predefined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of the scientific or business discipline. The categorization may then be used by a relational database to identify trends and discontinuities in the research efforts represented by the documents. However, Unger fails to anticipate the invention as defined by claims 1-9, 11, 12 and 20 for at

least the reason that Unger fails to disclose each and every claimed element as discussed below.

Independent claim 1 defines a method for managing data that includes, *inter alia*, the steps of creating a parameter file; establishing a link with a database; and importing bibliographic data from the database based on the parameter file. In addition, the imported data is sorted and grouped into at least one category and stored in at least one internal database. The categorized data can then be retrieved and displayed based on user selected categories.

In rejecting claim 1, the Examiner asserts that the stored categories illustrated in Fig. 1 of Unger "at least comprise a parameter file that is clearly linked to the database." However, nowhere in Unger is there any disclosure or suggestion of a parameter file as claimed.

The stored categories pointed to by the Examiner are a part of what Unger refers to as a customized technical subject hierarchy which models the specific interests of a business entity or technical specialty. This model consists of two or more levels, each level consisting of sets of categories (i.e., stored categories) which define the concepts being modeled. Accordingly, these stored categories make up the linking of patent or technical information into a specific subject category. However, such a linking does not inherently include a parameter file as claimed.

Therefore, the disclosure of a stored category does not inherently disclose creating a parameter file and importing data based on the parameter file as claimed for at least the reason that creating a parameter file does not *necessarily* flow from the disclosure of linking patent information into a subject category. Furthermore, the parameter file of the present invention is used to import patent data into an internal database, not categorize data that has been previously imported as disclosed in Unger's Stage IV. Accordingly, Unger fails to anticipate independent claim 1 for at least the reason that Unger fails to disclose each and every claimed feature.

Claims 2-9, 11 and 12 variously depend from independent claim 1. In addition, independent claim 20 defines a program product that includes, among other things, executable code for creating a parameter file and importing bibliographic data

from a linked database based on the parameter file. Therefore, claims 2-9, 11, 12 and 20 are patentably distinguishable over Unger for at least those reasons presented above with respect to claim 1. Accordingly, claims 1-9, 11, 12 and 20 are grouped together for his appeal.

C. Claim 10 and 13-19 Are Not Properly Rejected Under 35 U.S.C. §103(a) As Being Unpatentable Over Unger.

It is well known that in order to support a rejection under 35 U.S.C. §103, the Examiner must establish a *prime facie* case of obviousness. Furthermore, it is well known that in order to establish a *prime facie* case of obviousness, three basic criteria must be met. First, there must be some motivation to combine or modify the applied reference(s). Second, there must be a reasonable expectation of success. Finally, the combination/modification must disclose each and every claimed element. In the present case, claims 10 and 13-19 are not properly rejected under 35 U.S.C. §103 for at least the reason that the Examiner failed to establish a *prime facie* case of obviousness as discussed below.

1. The Examiner Fails To Provide Proper Motivation to Modify the Teachings of Unger.

In rejecting claims 10 and 13-19, the Examiner asserts that it would have been obvious to modify the teachings of Unger to include various claimed features of the invention because the claimed features are the obvious result of the suggested modification. However, as discussed in §2143.01 of the MPEP, the mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification.

For example, in rejecting claims 10 and 16, the Examiner asserts that although Unger fails to disclose that the "data is *displayed* as a spreadsheet", it would have been obvious to one skilled in the art to provide such a display because the "lack of such a display would tend to defeat the purpose of a spreadsheet, which is bound to its display." However, nowhere in Unger is there any suggestion that a spreadsheet is bound to its display, to the contrary Unger

specifically discloses displaying the organized data in a graphical format. Furthermore, it is well known in the art that applications which organize data in a spreadsheet format can be used to display the data contained within the spreadsheet in a graphical format, for example bar charts, pie charts, and the like. Accordingly, Applicant is unclear what the Examiner means by the spreadsheet being bound to its display.

In rejecting claim 19 the Office Action asserts that patents themselves include the references cited and the "references that cite a patent can be retrieved by well known commands in patent search engines." However, nowhere in Unger is there any disclosure or suggestion of retrieving the references cited by a patent, nor does the Examiner provide any motivation for modifying Unger to include such a feature.

Accordingly, the rejection of claims 10 and 13-19 under 35 U.S.C. §103 in view of Unger is improper for at least the reason that the Examiner fails to provide proper motivation for the modification to Unger.

2. The Modification of Unger Fails to Disclose Each and Every Claimed Element.

As discussed above, the third criteria required to establish a *prime facie* case of obviousness is that the combination/modification must teach every and every claimed element. In the present case, claims 10 and 13-19 are not rendered unpatentable over Unger for at least the reason that Unger fails to disclose each and every claimed element as discussed below.

Claim 10 recites, *inter alia*, that the retrieved records are displayed in a spreadsheet format *in accordance with a user's preference selection*. Accordingly, claim 10 stands alone.

In rejecting claim 10, the Examiner asserts that it would have been obvious to modify Unger to display data in a spreadsheet. However, displaying data in accordance with a user's preference selection does not explicitly or implicitly flow from displaying data as a spreadsheet. Nowhere in Unger is there any disclosure or suggestion of displaying data in accordance with a user's preference selection. Therefore, even if one skilled in the art were motivated to display data as a

spreadsheet, as suggested by the Examiner, such a display would not in and of itself render claim 10 unpatentable.

Claim 13 defines a system for acquiring and presenting data. The system includes, *inter alia*, a computer for establishing a link with a database and importing data from the database, a memory that stores the imported data in various groupings and categories, and a selection component that allows a user to select particular data of a record and the format of the data for display. Claims 14-17 depend from independent claim 13. Accordingly, claims 13-17 stand or fall together.

In rejecting claim 13, the Office Action asserts that it would have been obvious to one skilled in the art to use an internal parameter as a common link. However, the Office Action does not address the fact that Unger fails to disclose a selection component that allows a user to select particular data of a record and the format of the data for display. Therefore, claim 13, and claims 14-17 which depend therefrom, are patentably distinguishable over Unger for at least the reason that Unger fails to disclose or suggest a selection component that allows a user to select particular data of a record and the format of the data for display.

Claim 18 recites, *inter alia*, that a user can mark the imported data with an indication of priority. Accordingly, claim 18 stands alone.

In rejecting claim 18, the Examiner asserts that "patents themselves include priority data." However, the fact that patents may include "priority data" is not germane to the limitation of claim 18 inasmuch as claim 18 recites that a user can prioritize the imported data, not that the data includes priority information with regard to patents. Therefore, the fact that patents contain priority data is not sufficient to overcome the deficiencies of Unger.

Claim 19 recites, *inter alia*, that the imported data includes the number of references cited to a patent. Accordingly, claim 19 stands alone.

In rejecting claim 19, the Examiner asserts that patents themselves include the references cited and the "references that cite a patent can be retrieved by well known commands in patent search engines." However, nowhere in Unger is there any disclosure or suggestion of retrieving the *number* of references cited to a patent.

Therefore, even if one skilled in the art were motivated to modify Unger to retrieve the references that cite a patent, the modification would still fail to render claim 19 unpatentable.

IX. Conclusion

In view of the foregoing, it is respectfully requested that the rejections of claims 1-20 be reversed.

Respectfully submitted,

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APPENDIX A

The Appealed Claims

Claim 1: A method for managing data, comprising the steps of:

- creating a parameter file;
- establishing a link with a database;
- importing bibliographic data from the database based on the parameter file;
- grouping the imported data into at least one category;
- storing the bibliographic data in at least one internal database;
- linking together the corresponding imported data to form a record;
- selecting at least one category for viewing;
- retrieving the records from the selected categories; and
- displaying the records by the selected categories.

Claim 2: The method of claim 1, wherein the imported data is linked to corresponding imported data by a tight link.

Claim 3: The method of claim 2, wherein the tight link corresponds to an access number and/or a patent number.

Claim 4: The method of claim 3, wherein the selected data is displayed in a graphical format.

Claim 5: The method of claim 1, wherein the groupings of the data are chosen by the user.

Claim 6: The method of claim 1, wherein the groupings are listed in categories named by the user.

Claim 7: The method of claim 1, wherein data imported from at least one database provide information to each of the patents or documents cited for a particular patent or group of patents.

Claim 8: The method of claim 1, wherein each internal database stores a predetermined category of imported data.

Claim 9: The method of claim 1, wherein a said parameter file is created, prior to importation of data, which contains various categories of bibliographic data for an individual record.

Claim 10: The method of claim 1, wherein the data is displayed in a spreadsheet format in accordance with a user's preference selection.

Claim 11: The method of claim 1, wherein the displayed data can be manipulated by a user in order to view the data most relevant to the user's needs.

Claim 12: The method of claim 1, wherein the bibliographic data pertains to patents.

Claim 13: A system for acquiring and presenting data, comprising:

a computer that establishes a link with a database and imports data from the database based on a parameter file,

a memory that stores the imported data in various groupings and categories;

an internal parameter that links corresponding data with each other to form a record of data;

a selection component that allows a user to select particular data of a record and the format of the data for display; and

a presentation device that displays the selected data.

Claim 14: The system of claim 13, wherein the imported data is bibliographic data related to patents.

Claim 15: The system of claim 13, wherein the data is linked by the internal parameter according to access number and/or patent number.

Claim 16: The system of claim 13, wherein the data is provided in a statistical spreadsheet format.

Claim 17: The system of claim 13, wherein the data is presented in a graphical format.

Claim 18: The system of claim 13, wherein data may be marked by the user with an indication of priority.

Claim 19: The system of claim 13, wherein the data imported includes the number of references cited to a patent.

Claim 20: A computer readable medium containing a program which executes the following steps:

- creating a parameter file;
- establishing a link with a database;
- importing data from the database based on the parameter file, where the data includes bibliographic data;
- grouping the imported data into at least one category;
- storing the grouped bibliographic data in at least one internal database;
- linking corresponding imported data to form a record;
- selecting at least one category for viewing;
- retrieving the records from the selected categories; and
- displaying the records by the selected categories.